

REMARKS

The Office is requiring restriction to one of the following groups:

Group I: Claims 1-11, drawn to a wiring member; and

Group II: Claims 12-20, drawn to a method of making a wiring member.

Applicants have elected Group I, claims 1-11, drawn to a wiring member, with traverse.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Office if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Office to provide reasons and/or examples, to support any conclusion in regard to patentable distinctness (M.P.E.P. § 803). Applicants respectfully traverse the restriction requirement on the grounds that the Office has not carried the burden of providing sufficient reason and/or examples to support any conclusion that the claims of the restricted groups are patentably distinct.

The Office has categorized the relationships between Groups I and II a process of making and product made. Patentable distinctness may be shown if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). The Office alleges that the wiring member of Group I can be made by placing a mask over the porous substrate, slurry coating a conductive material over the mask, removing the mask, and heating/drying the conductive material. The Office also alleges that the process of Group II can be used to make security paper or a transfer.

The Office, however, does not meet the requirements of M.P.E.P. § 806.05(f), since the allegations are not evidence that the claimed wiring member can be made by another and materially different process. In particular, as recited in the present specification at page 2,

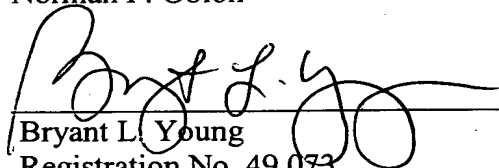
lines 2-12, using a "mask" in the process makes it "difficult to promptly cope with changes in designs of wiring patterns." As such, the claimed process has been developed to overcome such disadvantages, in order to make the specifically claimed wiring pattern. Moreover, the Office has not provided any evidence that the claimed process can be used to make security paper or a transfer, or clearly defined what the Office is generally referring by the terms security paper and transfer. Therefore, Office's reasoning is merely a restatement of the Office's conclusion that the groups are patentably distinct, which is believed to be improper.

Accordingly, for at least the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary to sustain the restriction requirement.

Withdrawal of the requirement is respectfully requested.

Respectfully submitted,

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